

Serial No. 09/672,181

Ullmann, Lorin Evan

Page 13 of 16

Section IV:
AMENDMENT UNDER 37 CFR §1.121
REMARKS

Request for Telephone Interview

Applicant hereby requests a telephonic interview with examiner prior to issuance of the next Office Action in this patent application in order to discuss any questions the examiner may have about the amendment contained herein, and to consider any suggestions examiner may have which would place the claims in an allowable state in the examiner's opinion. If any such suggestions are received from the examiner and are acceptable to the applicant, a supplemental amendment could be filed prior to issuance of the next Office Action in order to allow that next action to be a Notice of Allowance.

Applicant requests examiner to notify applicant's agent Robert Frantz at 405-812-5613 of a time and date which would be convenient for the examiner to receive a telephone call from the applicant's agent.

Rejections under 35 U.S.C. §102(e)

In the Office Action, the examiner has rejected claims 1 - 31 under 35 U.S.C. §102(e) for lack of novelty as being anticipated by U.S. Patent Number 6,189,026 to Birell, *et al.* (hereinafter "Birell").

Our claimed invention differs substantially from the Birell system in a number of ways, especially in the use of our new "Sender-chain" header tag and list. An email which is chain-sent is forwarded and replied to several times, often creating a long body of text with each previous message and reply appended to it. By reviewing this text, one can see an apparent "chain" of senders, such as first authored by Bob, then sent to Sue, who forwarded it to Ed, who then replied to Bob. This apparent sequence of recipients (and their addresses) however is not necessarily reflected in an email's normal "TO:", "FROM:", "REPLY-TO", and "CC:" fields, as these fields only list the recipients of the *current message* (e.g. the most recently sent message in the chain).

Our invention assists a message recipient in determining if the message has been chain-

Serial No. 09/672,181

Ullmann, Lorin Evan

Page 14 of 16

sent by first searching the body of the message, finding addresses of previous senders of the message, creating our new "Sender-Chain" tag and list, and adding the new tag and list to the message header when it is forwarded to the next recipient. Please note that our dependent claims 5 and 17 as originally filed specifically recited our newly defined "Sender-Chain" field, while our other claims referred to this field more descriptively.

Birell does not produce a new Sender-Chain tag such as this, but rather assists the user in addressing an email to an address contained in the normal message header fields (e.g. TO, FROM, CC, REPLY-TO), and found in the body of the message. Birell does not, however, attempt to determine a chain or sequence of recipients, and does not produce or use such a Sender-Chain field.

For the steps and elements in our claims which originally referred to such a sequential list of chain senders, the examiner cited the two portions of Birell's disclosure as teaching these steps or elements:

A term such as "from:fred" searches for messages with the word "fred" in the "from" field of a message header. Similar queries can be formulated for the "to," "from," "cc," and "subject" fields of the header. (Col. 9, lines 56 - 60)

When displaying retrieved messages, the system 200 heuristically locates text strings which have the syntax of e-mail addresses. If the user click on one of these addresses, then the system will display a composition window, described below, so that the user can easily generate a reply message to the selected e-mail address(es). (Col. 12, lines 16 - 21)

Birell is silent as to use of or creation of our Sender-Chain tag and address list which represents a sequence of previous senders of the message (e.g. chain senders), as we have disclosed in our patent application.

We have amended our claims to more specifically refer to our new Sender-Chain tag and list in order to be certain that it refers to the functionality and structure disclosed and defined in our patent application. Our claims cover not only use of this list of chain senders in a message which is received and already has the special list in its header, but also the creation of such a list

Serial No. 09/672,181

Ullmann, Lorin Evan

Page 15 of 16

when it is clear from the body of the message that it is a chain-sent message but our new tag is not currently included in its header.

1. The cited reference, Birell's patent, does not properly anticipate the claimed invention, as it fails to disclose all the claimed steps, elements or limitations. MPEP 2131 states:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
EVERY ELEMENT OF THE CLAIM (*capitalization emphasis found
in original text*)

Because the facts of the case as set forth above indicate that the cited reference does not properly teach all the steps, element or limitation of the claim, we request withdrawal of the rejections of claims 1 - 31.

2. The cited reference, Birell's patent, does not properly anticipate the claimed invention, as it fails to disclose all the claimed steps, elements or limitations as set forth according to the applicant's terminology. MPEP 2173.01 states:

MPEP 2173.01 Claim Terminology. A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art.

Further, MPEP 608.01 states:

The claims should be construed in light of the specification.

The facts of the case set forth above indicate that the cited reference does not properly teach all the steps, elements or limitations of our claims according to the terminology and definitions of our specification, we request the rejections of Claims 1 - 31 be withdrawn.

Serial No. 09/672,181Ullmann, Lorin EvanPage 16 of 16**Conclusion**

For the reasons set forth in the preceding paragraphs, the rejections are not supported by the cited art in view of our disclosure and definitions contained therein, and in view of the present amendment. Allowance of the claims as amended is hereby requested.

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